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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,345	03/10/2005	Mark Beckmann	112740-1051	6320
29177 7590 09/17/2007 BELL, BOYD & LLOYD, LLP P.O. BOX 1135 CHICAGO, IL 60690			EXAMINER PATEL, NIMESH	
			ART UNIT 2617	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/522,345

Applicant(s)

BECKMANN ET AL.

Examiner

Nimesh Patel

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Jul. 3, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### ***Detailed Office Action***

#### ***Response to arguments***

1. Applicant's arguments filed Jul. 3, 2007 have been fully considered but they are not persuasive.

Applicants argument stating on page 7 second paragraph of the remarks, that "Reddy fails to disclose that at least one of a type and an identity number of the wireless local network is transmitted to the terminal station following successful detection of local network activity" is not persuasive.

The examiner respectfully disagrees, as

Reddy **inherently** discloses, after successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is sent from the UTRAN node 120 to the MS or US 105 – S3A and S3B. Here, the system information needs to include **at least** the type of the wireless local network like, if the network is say CDMA, GSM, 3G, TDMA, along with the cell ID of the service provider cell and/or network ID that provides the service to the mobile, reads on the claimed feature, an identification number of the wireless local network (Figs. 1, 4/S10, 5/S16B, 6/S22B, and 7/S29B).

Applicants argument stating on page 7 last paragraph of the remarks that "Reddy fails to disclose the feature of initiating a local connection between the wireless local network and the terminal station", is not persuasive.

The examiner respectfully disagrees, as Reddy **inherently** discloses, in another embodiment, mobile unit 200 may simultaneously communicate with the cellular network 405 and the IP-based network 410. Alternatively, the mobile unit 200 may communicate with a wireless local area network – LAN, rather than IP-based network 410 (Fig. 4, paragraph 0031 - last 10 lines, and paragraph 0037 – first 5 lines ).

Applicant's other arguments with respect to claims 16 - 30 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Claims rejection – 35 U.S.C. 112 2<sup>nd</sup> paragraph***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 - 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant claims "polling specific subscriber data of the wireless local network" ( in claims 16, 23 and 30), is this kind of downloading the data from the network specific to subscriber and stored at UICC? Say, the subscriber is roaming between different networks, and the NEW subscriber data needs to be downloaded for the new network.

The question is what happens after an UMTS terminal is polling data of the wireless local network?

Or is this subscriber data is polled from the UICC?

This makes the claim indefinite, as it is OPEN ENDED after polling the data from the network.

### ***Claims Rejection – 35 U.S.C. 103(a)***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 16, 17, 19, 23, 24, 26, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Reddy, US PGPub: US 2004/0043791A1 Mar. 4, 2004, and in view of  
Lin, US Patent: 6,078,811 Jun. 20, 2000.

**Regarding claims 16, 23 and 30**, which claims, "a wireless local network", Reddy discloses, a Wireless Local Area Network – WLAN (paragraphs 0031 and 0037, claims 20 and 23).

Further claimed feature, "a UMTS terminal station having USIM/SAT functionality", Reddy discloses, in 3<sup>rd</sup> Generation – 3G Universal Mobile Telecommunication Systems – UMTS, User Equipment – UE consists of Mobile Equipment – ME and a removable smart card called the UMTS Subscriber Identity Module – USIM (Fig. 1, and paragraphs 0003, 0004, 0006, 0007, 0015, 0016 and 0030).

Further claimed feature, "parts for monitoring activity of the wireless local network", Reddy discloses, when request to connect the MS 110 is received – S1, the PLMN and IMSI information is transferred from the USIM or SIM card 115 to the handset 110 for facilitating an initial cell search and to camp on the cell determined from the search – S2. After successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is sent from the UTRAN node 120 to the MS or UE 105 – S3A and S3B (Fig. 1). The handset has unique handset identity for transmitting, receiving and processing wireless communications. The handset selectively transmits information to one or more networks for establishing a communication link with the networks.

Here, the handset is searching for cell, teaches the handset monitors the network, and after successful searching, the handset receives system information, so the handset has claimed parts for monitoring activity of the wireless local network (paragraph 0016).

Further claimed feature, "after successful detection of local network activity, parts for transmitting **at least one** of a type and an identity number of the wireless local network **to the terminal station**", Reddy discloses, After successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is



Art Unit: 2617

sent from the UTRAN node 120 to the MS or UE 105 – S3A and S3B. Here, the system information needs to include **at least** the type of the wireless local network like, if the network is say CDMA, GSM, 3G, TDMA, along with the cell ID of the service provider cell and/or network ID that provides the service to the mobile, reads on the claimed feature, an identification number of the wireless local network (Figs. 1, 4/S10, 5/S16B, 6/S22B, and 7/S29B).

Further claimed feature, "parts for **initiating** a logical connection between the wireless local network and the terminal station", Reddy discloses, the handset 220 or UE 105 sends a connection request including the stored IMSI information to the Core Network 125 through UTRAN node 120 or with IP address (Figs. 4/S9 and S11, 5/S17, 6/S23, 7/S30). Here, the handset is initiating a logical connection between the handset and core network, through UTRAN Node 120. Here, Reddy teaches, once the mobile unit receives the system information, the mobile initiates the connection request with IP address and/or User information to UTRAN node 120,

but, is silent on, "using an existing connection" and "parts for polling specific subscriber data of the wireless local network for the logical connection".

Art Unit: 2617

Lin teaches, "using an existing connection", the existing mobile user U1 sends req\_msg to VLR2 of the visiting network (Fig. 7, step s6.3, column 6, lines 13 – 49 ),

Lin further teaches, "parts for polling specific subscriber data of the wireless local network for the logical connection", the VLR2 requests profile of the mobile user U1 from the HLR. Here, the VLR2 is polling the specific subscriber data, which can include what kind of the wireless network systems the mobile subscriber can use, specific features that the mobile subscriber had accessed, reads on the claimed feature, polling specific subscriber data of the wireless local network for the logical connection (Fig. 7, steps s6.3 - s6.6, column 6, line 50 through column 7, line 11).

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (Fig. 2/200), would have incorporated the handset (the handset sends request message to VLR2, and VLR2 polls the data from the HLR and passes on to the subscriber, polls specific subscriber data of the wireless local network ( Lin, Fig. 7) of Lin, for the mobile station selectively transmits information to one or more networks for establishing a communication link with the network (Reddy, paragraph 0016).

**Regarding claims 17 and 24,** Reddy discloses all the claimed features,

but, is silent on, "polling a temporary status of at least one of the wireless local network and the specific subscriber data of wireless local network at periodic intervals".

Lin teaches, "parts for polling specific subscriber data of the wireless local network for the logical connection", the VLR2 requests profile of the mobile user U1 from the HLR. Here, the VLR2 is polling the specific subscriber data, which can include what kind of the wireless network systems the mobile subscriber can use; specific features that the mobile subscriber had accessed, reads on the claimed feature, polling specific subscriber data of the wireless local network is polled periodically. Here, the VLR2 itself stating for visiting location register, and it self explains that the information stored for status of wireless local network and the specific subscriber data is temporary, as once the mobile subscriber visits another VLR2, the information specific to the mobile subscriber is overwritten at the VLR2 (Fig. 7, steps s6.3 - s6.6, column 6, line 50 through column 7, line 11).

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (Fig. 2/200), would have incorporated the handset (the handset sends request message to VLR2, and VLR2 polls the data

from the HLR and passes on to the subscriber, polls temporary specific subscriber data of the wireless local network ( Lin, Fig. 7) of Lin, for the mobile station selectively transmits information to one or more networks for establishing a communication link with the network (Reddy, paragraph 0016).

**Regarding claims 19 and 26**, which claims, "the terminal station comprises a universal chip card which initiates the monitoring of the activity of the wireless local network and the transmission of data to the terminal station", Reddy discloses, in 3<sup>rd</sup> Generation – 3G Universal Mobile Telecommunication Systems – UMTS, User Equipment – UE consists of Mobile Equipment – ME and a removable smart card called the UMTS Subscriber Identity Module – USIM (Fig. 1, and paragraphs 0003, 0004, 0006, 0007, 0015, 0016 and 0030).

Reddy discloses, when request to connect the MS 110 is received – S1, the PLMN and IMSI information is transferred from the USIM or SIM card 115 to the handset 110 for facilitating an initial cell search and to camp on the cell determined from the search – S2. After successful camping on a cell MS or UE receives system information. A communication link between the MS or UE 105 and a UTRAN node 120 is established, and system information is sent from the UTRAN node 120 to the MS or US 105 – S3A and S3B (Fig. 1). The handset has unique handset identity for transmitting, receiving and processing wireless

communications. The handset selectivity transmits information to one or more networks for establishing a communication link with the networks.

Here, the handset is searching for cell, teaches the handset is monitors the network, and after successful searching, the handset receives system information, so the handset has claimed parts for monitoring activity of the wireless local network (paragraph 0016).

Claims 18, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy, US PGPub: US 2004/0043791A1 Mar. 4, 2004, and in view of Lin, US Patent: 6,078,811 Jun. 20, 2000, and further in view of Le, US Patent: US 6,556,820 Apr. 29, 2003.

**Regarding claims 18 and 25**, both Reddy and Lin, discloses all the claimed features,

but, are silent on, "the specific subscriber data includes a type/identity number, a subscriber identification, a password, a secret key for data encryption and decryption and an address of an access node".

Le teaches, the mobile can initiate a location update either on its own or on command from the network – periodic location update. The location areas are identified by Location Area Identification – LAC (column 9, lines 4 – 20). Each

cell has the cell identity – CI, which the network node broadcasts. Here, when it is initiated by the network command, which is the same as the claimed polling subscriber data of the wireless local network. The mobile station 110 consists of Mobile Equipment 124, and SIM 126 (Fig. 1, Fig. 9/930 – dual mode terminal), the SIM/USIM card 205 contains the International Mobile Subscriber Identity – IMSI, used to identify the subscriber to the system, a secret key for authentication and **other information** (column 6, lines 21 – 29).

Here, the other information can include the specific subscriber data, type/identity number, a subscriber identification, a password, a secret key for data encryption and decryption, and an address of an access node.

Le further teaches, handovers between UMTS and GSM (Fig. 9).

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy and Lin, wherein, the handset with USIM card (combined Reddy and Lin, Fig. 2/200), the handset polls specific subscriber data of the wireless local network (Le, Figs. 1 and 2), and the mobile station can initiate update the subscriber location information or react on network command, for reducing a waste of processing load on the terminal and the various network nodes (Le, column 2, lines 54 – 58), for the mobile station selectively transmits information to one or more networks for establishing a communication link with the network (Reddy, paragraph 0016).

Claims 20 – 22, 27 - 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Reddy, US PGPub: US 2004/0043791A1 Mar. 4, 2004, and in view of Lin, US Patent: 6,078,811 Jun. 20, 2000, and in further view of 3GPP TS 31.111 version 4.5.0 Release 4, 2001-12.

**Regarding claims 20 and 27,** Reddy and Lin discloses all the claimed features, but, are silent on, “the terminal station notifies the universal chip card of a deactivation of the wireless local network”.

The technical specification 3GPP TS 31.111 version 4.5.0 Release 4, Dec. 2001 teaches, once the ME has made its attempt to execute a proactive command from the UICC, the ME shall inform the UICC of the success or otherwise of that command, by using TERMINAL RESPONSE. This message gives the command details, including the number of command, a general result and sometimes more specific information (Section: 6.7). It also teaches, ME informs UICC for NO SERVICE is currently available, NO radio resource currently available, which reads on the claimed “the terminal station notifies the universal chip card of a deactivation of the wireless local network”.

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (combined Reddy and Lin, Fig. 2/200), for the mobile station selectively transmits information to one or more networks for establishing a communication link with the network (Reddy, paragraph 0016), and further notifying the status information to the universal chip card of the commands initiated by the universal chip card, for avoiding suspension of service provisioning to the user and to allow the ME access to the 3G functionality of the UICC if a USAT application is taking an unreasonable amount of time to complete execution (3GPP standard, section 6.1, lines 5 – 10).

**Regarding claims 21 and 28,** Reddy and Lin discloses all the claimed features,

but, are silent on, “the universal chip card initiates a cleardown of the logical connection between the wireless local network and the terminal station”.

The technical specification 3GPP TS 31.111 version 4.5.0 Release 4, Dec. 2001 teaches, the UICC can issue variety of commands like DISPLAY TEXT, POLL INTERVAL, RECEIVE DATA, PROVIDE LOCAL INFORMATION, SEARVICE SEARCH, SET UP CALL – disconnecting all other calls and many more (section 6.1). Here, disconnecting call reads on the claimed “the universal chip card



Art Unit: 2617

initiates a cleardown of the logical connection between the wireless local network and the terminal station”.

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (combined Reddy and Lin, Fig. 2/200), and the mobile station selectively transmits information to one or more networks for establishing a communications link with the networks (Reddy, paragraph 0016), and further notifying the status information to the universal chip card of the commands initiated by the universal chip card, for avoiding suspension of service provisioning to the user and to allow the ME access to the 3G functionality of the UICC if a USAT application is taking an unreasonable amount of time to complete execution (3GPP standard, section 6.1, lines 5 – 10).

**Regarding claims 22 and 29,** Reddy and Lin discloses all the claimed features,

but, are silent on, “the terminal station acknowledges all data transmitted”.

The technical specification 3GPP TS 31.111 version 4.5.0 Release 4, Dec. 2001 teaches, once the ME has made its attempt to execute a proactive command from the UICC, the ME shall inform the UICC of the success or otherwise of that command, by using TERMINAL RESPONSE. This message gives the command

Art Unit: 2617

details, including the number of command, a general result and sometimes more specific information (Section: 6.7). It also teaches, ME informs UICC for NO SERVICE is currently available, NO radio resource currently available, which reads on the claimed "the terminal station notifies the universal chip card of a deactivation of the wireless local network".

It would have been obvious to one of ordinary skill in the art, at the time of invention, to modify mobile unit having internet protocol functionality of Reddy, wherein, the handset with USIM card (combined Reddy and Lin, Fig. 2/200), and the mobile station selectively transmits information to one or more networks for establishing a communications link with the networks (Reddy, paragraph 0016), and further notifying the status information to the universal chip card of the commands initiated by the universal chip card, for avoiding suspension of service provisioning to the user and to allow the ME access to the 3G functionality of the UICC if a USAT application is taking an unreasonable amount of time to complete execution (3GPP standard, section 6.1, lines 5 – 10).

**Contact Information**

Any inquiry concerning this communication from the examiner should be directed to Nimesh Patel at (571) 270-1228, normally reached on Mon-Thur. 7:30 AM to 6:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez can be reached on (571) 272-7915.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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